

The Examiner takes the position that Group I or Group II claims are "sub-combinations" that can be used together in a single combination. This invokes Manual of the Patent Examining Procedure (MPEP) § 806.05(d).

B. Traversal of Restriction Requirement

The restriction requirement is respectfully traversed. It is submitted that claims of Group I and Group II do not meet the criteria of MPEP § 806.05(d).

Independent claim 1 of Group I and independent claims 15 and 16 of Group II are not believed to be "sub-combinations". Claim 1 has three steps. Step (a) involves defining a "set of observable behavioral characteristics relevant to a performance in jobs". Step (b) involves surveying "subject matter experts having knowledge or experience relative to the job to derive how such characteristics relate to the job". Step (c) involves "defining the job based on said surveying".

In comparison, claim 15 has as a first step "determining a Set of Competencies". Page 16 of Applicants' specification defines the terms "Competency" and "Set of Competencies" (see lines 23-28). "Competency" is defined as "a behaviorally related observable characteristic in the work place relative to a particular job from the Set of Competencies defined herein." The second step of claim 15 involves surveying "one or more persons having prior familiarity with the position". The third step of claim 15 involves "deriving performance criteria relative to the job based on the surveying". The final step is "reporting said performance criteria".

Claim 16 is a system claim including a computer and software. However, claim 16 continues, defining the software by stating the software generates "a survey for one or more

incumbents in a given job or position, the survey being based on a set of observable behaviors for performance in jobs". The last element of claim 16 involves "compiling answers to said survey and generating a report characterizing the job or position based on the observable behaviors".

Therefore, all three claims 1, 15, and 16 involve (a) defining or determining a set of observable behavioral characteristics relevant to performance of the job, *i.e.* a "Set of Competencies"; (b) surveying persons having some intelligence regarding or experience in the specific job; and (c) defining or generating a report that characterizes the job based on compilation of the surveys in relation to the competencies or behavioral characteristics. Thus, it is respectfully submitted that the claims of Group I and Group II are not "sub-combinations". This is corroborated by the preambles of claims 1, 15, and 16. Claim 1 is "[a] method of developing criteria of performance for job position". Claim 15 is "[a] method for identifying competencies (soft skills) required for superior performance for a given job". Claim 16 is "[a] system for identifying competencies (soft skills) required for superior performance for a given job". All three relate to a method or system related to characterizing what characteristics or competencies are indicated for performance for a job. Claim 1 develops "criteria of performance". Claims 15 and 16 "identify competencies". As previously mentioned, competency is an observable characteristic relative to the particular job and therefore relates to criteria or competencies for performance for a job.

But further, MPEP § 806.05(d) requires that there be separate utility for each group of claims. The Office Action states "invention I does not require the step of determining a Set of Competencies as claimed in invention II". But as previously pointed out, claim 1 requires "defining a set of observable behavioral characteristics relative to a performance in jobs".

Specification page 16, lines 23-26 define "competency" as "a behaviorally-related observable characteristic in the work place relative to a particular job...". Thus, the relationship between the two clauses in claims 1 and 15 or 16 is direct.

Therefore, it is respectfully submitted that there has not been a showing that the claims of Group I and Group II are independent and distinct. It is therefore respectfully submitted the restriction requirement should be withdrawn and that all claims should proceed together to examination.

C. *Provisional Election*

Applicant provisionally elects Group I, claims 1-14 for prosecution, with traverse and without prejudice to pursue the non-elected claims in a related application.

D. *Conclusion*

It is respectfully submitted that all matters raised in the immediately preceding Office Action (Restriction Requirement), have been addressed and remedied and that the application is in order for consideration on the merits.

E. *Petition for Extension of Time and Fee*

Applicants hereby petition for a five-month extension of time to respond to the Restriction Requirement. Accompanying this response is a check in the amount of \$985.00, the government fee for the extension of time.

It is not believed that any additional fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,


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